

Appl. No. 10/689,910  
Atty. Docket No. 9391  
Amdt. dated 2/16/07  
Reply to Office Action of 11/20/06  
Customer No. 27752

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#### REMARKS/ARGUMENTS

Claims 1-3, 6, 7 and 9 are now under consideration.

Claim 1 has been amended to recite the precipitation step (d). Basis is found *inter alia* at page 12, penultimate line ("The resulting precipitated theanine . . .")

Claims 5 and 10 have been cancelled herewith without prejudice as redundant, in view of the amendments to Claim 1. Claims 6 and 7 now depend from Claim 3. Claims 11-20 have been cancelled without prejudice, in view of the previously-made restriction requirement.

#### Rejections Under 35 USC 112

It is submitted that the amendment to Claim 1, the cancellation of Claim 5, and the amendments to Claims 6 and 7, fully meet the rejections at pages 2-3 of the Office Action. Withdrawal of the rejections is requested.

#### Rejections Under 35 USC 103

Claims 1-3, 9 and 10 stand rejected under §103 over the Kubota, et al., document in view of Ford (US 5,141,611), the Zhongyu, et al., document and Ekanayake, et al., (US 5,879,733), for reasons of record at pages 4-7 of the Office Action.

Applicants respectfully traverse the rejections over this combination of documents. Applicants' basis for urging patentability of the claims, as now amended, is based on the following line of reasoning.

- 1.) The '733 patent teaches that a "key aspect" of the disclosed invention is to treat the tea extract with a food grade cation exchange resin. (Col. 6, lines 21-21.) This is to remove metal cations which can undesirably catalyze oxidation reactions in the extract. (Column 6, lines 22-24.) The process thus assertedly provides extracts with improved clarity. (Column 6, line 27.) Various cation exchange resins, including several Amberlite™ resins, are disclosed at Column 7, beginning at line 9.

Once treated with the cation exchange resin, the tea extract of '733 is nanofiltered. (Column 7, lines 65-67.) As noted in the previous responsive amendment, the nanofilter is taught not to comprise polyamide material, since that would remove

Page 4 of 6

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too much of the catechins which are a desirable component of the '733 extract.  
(Column 9, line 10.)

- 2.) The Zhongyu publication (Abstract) teaches that tea polyphenols are extracted by polyamide.
- 3.) The '611 patent teaches that polyphenolic substances are adsorbed on polyamide of "extended surface and controlled porosity."
- 4.) The Kubota publication discloses analytical techniques for amino acids (including theanine) present in tea. A discussion of six separate methods for preparing samples used in the analysis indicates that the preparative method chosen can affect the theanine measurement. ["It was clarified that the former indicates a large loss of theanine . . . ." Kubota at page 18, column 3.]

It is submitted that a fair combined reading of the 4 cited documents would be as follows:

- i.) Zhongyu Abstract and '611 both teach the adsorption of tea polyphenols by polyamide and, in that respect, are merely cumulative. Neither document is directed to a process for isolating theanine.
- ii.) The Kubota document is concerned with analyzing tea extracts for theanine and describes the use (and problems!) of various ion-exchange resins during sample preparation.
- iii.) Like Kubota, the '733 patent employs ion-exchange resins, so Kubota adds nothing to '733 in that regard.
- iv.) Importantly, however, the process of '733 specifically avoids the use of polyamides. This is the exact opposite of the teachings of Zhongyu and the '611 patent.
- v.) And, '733 enriches in theanine. (Column 10, lines 41-42.)

Net: The only cited document ('733) that relates to theanine enrichment in tea extracts and employs nanofiltration specifically avoids contact of the extract with polyamide. Accordingly, to purport to combine '733 with Zhongyu or with '611 would fly in the face of the teachings of those latter two documents regarding the use of

Page 5 of 6

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polyamides in treating tea extracts. And, as noted, the other cited document, Kubota, adds nothing to '733.

What remains? If '733 is not combinable with Zhongyu or '611, and if Kubota is merely cumulative, then '733 stands alone. And, if '733 stands alone, then it clearly teaches away from the use of polyamide in the treatment process and, hence, teaches away from the use of polyamide as required in the present process.

It is submitted that the foregoing analysis of the purported combination of documents is fully in accord with controlling case law. As the Examiner is aware, prior art must be considered in its entirety, including disclosures that teach away from the claims; MPEP §2143.02 (case citations omitted). **Accordingly, the avoidance of the use of polyamides per the '733 patent must be considered, as a matter of law, when assessing the propriety of the combination.**

Moreover, as the Examiner is aware, the law does not allow the combination of references where the reference teaches away from their combination; MPEP §2145 X.D. (case citation omitted). **Accordingly, the combination of '733 (no polyamide) with Zhongyu (polyamide) and '611 (polyamide) is impermissible as a matter of law.**

Again, that leaves '733/Kubota. Since both teach treatment of tea extracts with ion exchange resin, Kubota adds nothing to '733. **And, '733 avoids polyamides in the treatment, contrary to the present invention.**

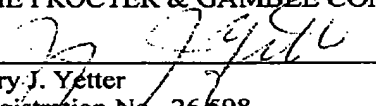
Overall Net: When, as here, the claimed method involves doing what the cited reference [the '733 patent] tries to avoid, "... [t]his is the very antithesis of obviousness." *In re Buehler*, 515 F.2d 1134, 1141 (CCPA 1975).

In light of the foregoing, withdrawal of the rejections and favorable action in the case are requested

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By

  
Jerry J. Yetter  
Registration No. 26,598  
(513) 627-2996

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Customer No. 27752

Page 6 of 6